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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3688

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10/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/914,287	Applicant(s) HONNEF ET AL.	
	Examiner KHANH H. LE	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 10, 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19,23-25,27,29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) 14,25 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13,15-19,23,24,27 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office Action is responsive to the correspondence filed July 10, 2008. Claims 1-19 and 23-31 are pending with claims 14, 25 and 29 previously withdrawn. No claims are added nor amended. Claims 26, 28, and 30 are cancelled. Hence claims 1-13, 15-19, 23, 24, 27, and 31 are herein examined. Claims 1, 23, 24, 27, and 31 are independent.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3, 5, 7-11, 13, 23, 24, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Phillips et al., US 6615189.**

Independent claims 1, 23, 24, and 27 and dependent claims 2, 8 and 10:

Phillips discloses:

A method of processing an electronic stored value certificate (abstract), comprising the computer-implemented steps of:

receiving and storing certificate information that identifies a recipient of the certificate, a recipient address (e.g. col. 4 lines 31-37), and an amount of the electronic stored value certificate (e.g. col. 3 lines 44-47);

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issuing the electronic stored value certificate from a certificate issuer in response to successfully carrying out a purchase transaction that transfers value from a first account associated with a purchaser of the electronic stored value certificate to a second account associated with a merchant; and

creating and storing a unique identification value for the electronic stored value certificate in association with the certificate information as part of issuing the electronic stored value certificate;

storing an initial face value of the electronic stored value certificate,

determining a new face value by reducing the initial face value of the electronic stored value certificate by a portion of the initial face value in response to receiving information indicating redemption at the merchant of the portion of the initial face value for goods or services, and

storing the new face value of the electronic stored value certificate (e.g. abstract; Figure 1 and associated text; col. 3 line 41 to col. 4 line 45 explicitly and/or implicitly disclose all the above steps);

displaying the new face value of the electronic stored value certificate to the recipient; repeating the steps of determining [[and]] storing, and displaying the new face value in response to successively received redemption information until the new face value of the electronic stored value certificate is zero (e.g. col. 4 lines 46-57; col. 5 lines 1-5; col. 2 lines 57-59 and 65-67: stored value card is used till balance is zero and recipient being able to add value to the card via internet suggests the claimed steps of displaying, storing, and redisplaying the new face value, to apprise recipient of current value, after successive redemptions, and to enable adding more value);

wherein the unique identification value is a random value (a unique identification value is implicit to uniquely identify the stored value card or account, see col. 3 lines 58-60; such value is also interpreted as being a random value);

wherein the unique identification value is operable for redemption of the electronic stored value certificate at the merchant by communication of the merchant with the certificate issuer in a redemption transaction that does not traverse the commercial credit card network and wherein the unique identification value is non-negotiable in a commercial credit card network (e.g. col. 3

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lines 58-67 and col. 3 lines 2-5 :even though the commercial credit card network may be an affiliate, it is only one possible embodiment in Philips ; a “third party processor” suggests a non-credit card entity).

(**Note:** The instant specification discloses tracking the face value but not specifically to a zero balance. Though this may be implied, it is noted PHILLIPS discloses as much as the specification.)

Claim 3:

PHILLIPS discloses the method of claim 1 above and further discloses the gift-giver profile is taken from prior sales data (Figure 1 and associated text: e.g. item 100: solicitation of gift-giver; item 140: access her profile).

Claims 5, 9 and 11:

PHILLIPS discloses the method of claim 1 above and further discloses redemption against many sellers' products (col. 5 lines 36-43) and necessary relationships with sellers are established (col. 5 lines 36-43). Implicitly that means remitting by a computer (e.g. Fig. 2 item 332 or Figure 1 items 190, 200, 220) to sellers the value corresponding to their products that gift recipient selects. Which reads on “generating and returning an amount redeemed to a merchant“.

Claim 7:

The limitations of claim 7 are interpreted as a redemption process by gift recipient wherein recipient information including certificate current balance is updated. As discussed above, PHILLIPS discloses the method of claim 1 above and thus discloses all limitations of claim 7.

Claim 13:

PHILLIPS discloses the method of claim 1 above and further discloses a call center for redemption (e.g. Figure 2 item 240 and associated text).

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips as applied to claim 1 above, and further in view of Walker et al., US 6138106.**

Claim 4:

Phillips discloses the method of claim 1 above. As discussed above, Phillips discloses displaying the new face value of the electronic stored value certificate to the recipient; repeating the steps of determining [[and]] storing, and displaying the new face value in response to successively received redemption information until the new face value of the electronic stored value certificate is zero (e.g. col. 4 lines 46-57; col. 5 lines 1-5; col. 2 lines 57-59 and 65-67: stored value card is used till balance is zero and recipient being able to add value to the card via internet suggests the claimed steps of displaying, storing, and redisplaying the new face value, to apprise recipient of current value, after successive redemptions, and to enable adding more value).

This means Phillips discloses “a statement” as claimed, because “a statement” is interpreted as the current value of the certificate.

Phillips discloses an email notification to recipient and recipient ability to view the certificate as discussed above but does not specifically disclose “a hyperlink that contains the unique identification value so the recipient may view the certificate”. However, as discussed in previous Office Actions, Walker discloses such electronic mail notification message to the recipient of the electronic stored value certificate that includes a hyperlink that contains the unique identification value so the recipient may view the certificate within a browser (col. 7 lines

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56-58; col. 5 lines 27-37). Thus it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a “PHOSITA”) to add such teaching of Walker to Phillips to facilitate viewing of the certificate and its status.

6. Claims 6, 12 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over PHILLIPS as applied to claim 1 above in view of legal precedents and/or Official Notice.

Claim 6: PHILLIPS discloses the method of claim 1 above. PHILLIPS does not specifically disclose” *applying the electronic stored value certificate to the order by reducing the current value of the electronic stored value certificate to zero) ; and attempting to receive the balance due for the order by carrying out a charge transaction that transfers value from an account associated with the recipient of the electronic stored value certificate to a certificate issuer with which the electronic stored value certificate may be redeemed; and restoring the electronic stored value certificate to its previously determined current value in response to failure of the charge transaction.”*

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However, PHILLIPS discloses the card balance is depleted against purchases till it becomes zero (*col.4 lines 48-54*) and recipient can add value by other means including charge cards (*col. 4 lines 54-56; col. 5 lines 1-8*).

Thus, in case the stored value card balance is insufficient for a certain purchase, it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a “PHOSITA”), from the PHILLIPS’s teachings above, to “appl[y] the electronic stored value certificate to the order by reducing the current value of the electronic stored value certificate to zero; and then attempt[t] to receive the balance due for the order by carrying out a charge transaction that transfers value from an account associated with the recipient of the electronic stored value certificate to a certificate issuer with which the electronic stored value certificate may be redeemed” in order to cover the insufficient funds” as claimed, (i.e. this would be an obvious alternative to allowing adding value to the stored value card, as taught by PHILLIPS) to allow completing the purchase.

Further, customarily if there are insufficient funds, the purchase would be void too. Thus in case the recipient attempts to add needed value by charge card and fails, it would have been obvious to a PHOSITA to void the purchase transaction and restore the electronic stored value certificate to its previously determined current value.

Claim 12:

PHILLIPS discloses the method of claim 1 above but does not specifically disclose selling its own a “merchant-branded” stored value certificate to gift giver. However it discloses stored value cards which are credit cards and which are co-branded with a sponsor (i.e. merchant) (*col. 5 lines 64-65*). Thus it would have been obvious to a PHOSITA to delete the credit card function if this function is not desired for any reason and arrive at the claimed invention because the deletion of the element with a corresponding loss of function has been held to be obvious, see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963).

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Claims 15-17:

PHILLIPS discloses the method of claim 1 above.

However PHILLIPS does not disclose (Claim 15) a condition to redeem a minimum purchase amount ; (claim 16) recipient needs be first time customer ; (claim 17) a condition to buy specified goods and services.

However, Official Notice is taken that it is old and well-known for companies to provide employee rewards or for merchants to provide loyalty values in the form of reward certificates. It would have been obvious to one skilled in the art at the time the invention was made to use the PHILLIPS system as a vehicle to effect providing such loyalty or reward values. It is also well-known to impose conditions, such as the claimed limitations above, usually for co-branding purposes or to promote sales of a sponsoring merchant. Thus it would have been obvious to a PHOSITA to impose the above claimed conditions to the PHILLIPS system to achieve the above co-branding, or sales promotions goals.

(Note: Phillips at col. 5 line 62 to col. 6 line 2, in another embodiment with stored card as credit card, is support for the Official Notice that a condition to buy specified goods and services (claim 17) is old and well-known).

Claims 18 and 19:

PHILLIPS discloses the method of claim 1 above.

However, PHILLIPS does not disclose taxes, shipping or handling charges added to the purchase total , and “determining whether applying the current value of the electronic stored value certificate to the amount of the order results in a balance due for the order, and if so, generating information that prompts the recipient to add value to the certificate.”

However, Official Notice is taken that taxes are often added to a purchase price and also it is customary to include shipping and handling charges. Thus when necessary, they obviously would have been added to a PHILLIPS 's purchase by a PHOSITA.

Further PHILLIPS discloses recipients adding value by charge card when the certificate value is not sufficient for the total purchase price (col. 9 lines 42-48 and 16-24).

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Thus, it would have been obvious to a PHOSITA to add the above claimed limitation to PHILLIPS, in case adding taxes, shipping or handling charges would exceed the gift value to afford the total purchase.

7. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over PHILLIPS in view of legal precedents.

Independent claim 31:

The limitations common to independent claims discussed above are disclosed by PHILLIPS as discussed above.

Further, Phillips's data service 200 dealing with many sellers is in effect a third party certificate issuer (e.g. Figure 1 items 190, 200, 220 or Fig. 2 item 332 and associated text; col. 5 lines 36-43).

In the alternative, claim 30 is method claim and having a third party issue the certificate does not affect the method in a manipulative sense. In other words the same steps are present i.e. issuing, activating, redeeming whether it is issuing and activating by the third party or not. Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961) held: “[To] be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.” Here, the third party merely uses the issuing/activating structures, and that does not affect the overall method, thus per Ex parte Pfeiffer, the third party issuer limitation is not given patentable weight.

PHILLIPS does not disclose a reseller of the gift certificate.

However, claim 31 is a method claim and having a reseller resell the certificate does not affect the method in a manipulative sense. In other words the same steps are present i.e. issuing, activating, redeeming whether it is issuing and activating by the reseller or not (i.e. no extra steps are claimed in view of the existence of a reseller). Ex parte Pfeiffer, 135 USPQ 31 (BdPatApp&Int 1961) held: “[To] be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount

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to the mere claiming of a use of a particular structure, which, in our opinion, is the case here.”

Here, the reseller merely uses the issuing/activating structures, and that does not affect the overall method, thus per Ex parte Pfeiffer, the reseller limitation is not given patentable weight.

Further, even in structure claims, it has been held that making parts separable would be obvious

“if it were considered desirable for any reason” . See In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (“*The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose."*”). Here the reason for adding a reseller

to PHILLIPS might be that the reseller performs the task more efficiently or at better costs.

Response to Arguments

8. Applicant's arguments filed July 10, 2008 have been fully considered but they are not persuasive.

a. Applicant argues Phillips does not disclose “*wherein the unique identification value is operable for redemption of the electronic stored value certificate at the merchant by communication of the merchant with the certificate issuer in a redemption transaction that does not traverse the commercial credit card network and wherein the unique identification value is non-negotiable in a commercial credit card network*” at e.g. col. 3 lines 58-67 and col. 3 lines 2-5 .

The examiner had interpreted that, in Phillips, “*even though the commercial credit card network may be an affiliate, it is only one possible embodiment in Philips ; a “third party processor” suggests a non-credit card entity*”. Applicants disagreed. However a specific definition of “*wherein the unique identification value is non-negotiable in a commercial credit card network*” can not be found in the specification thus the Examiner’s interpretation, under the

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broadest reasonable interpretation rule, that a “third party processor” can be considered a non-credit card entity, is reasonable. The Examiner notes that any negative limitation or exclusionary proviso must have basis in the original disclosure. See MPEP 2173.05(i). In absence thereof, the Examiner’s interpretation above is reasonable. (The Examiner thanks Mr. Gu for calling back on October 10 to let the Examiner know that, upon a quick review of the application, he has not been able to find a definition for such limitation in the specification either).

b. Applicant also argues that Phillips does not disclose a purchase transaction that transfers value from a first account associated with a purchaser of the electronic stored value certificate to a second account associated with a merchant. However, all this means is that means if the purchase card is used at the merchant the merchant’s account is credited with value which is transferred from the account of a purchaser of the purchase card. Applicant agrees “*Phillips describes a method in which an offeror such as a credit card issuer may issue a purchase card to a customer (see col. 3 lines 1-3). Specifically, Phillips at col. 3 lines 39-47 discloses that a transaction may be posted to a purchaser's credit card. In the same passage, Phillips states that, in another embodiment, a purchaser may use check, cash, or other financial methods to obtain a purchase card.*” Thus Phillips discloses exactly that if the purchase card is used at the merchant the merchant’s account is credited with value which is transferred from the account of a purchaser of the purchase card.

c. Applicant also argues:” *Phillips specifically teaches away from an approach in which electronic stored value certificate, issued after a transfer of funds to an account of a merchant, is redeemed at the same merchant that has received the transferred value as claimed. See col. 1 lines 25-29.*” However this approach (underline emphasis added) is not claimed.

d. Applicant also argues the card of Phillips has no display capability and is not itself depicted on a screen or display. However the card having display capability is not claimed. Also it is not the card itself being depicted on a screen or display that is claimed but “displaying the new face value of the electronic stored value certificate”.

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The Examiner had explained how Phillips suggests this: at col. 4 lines 46-57; col. 5 lines 1-5; col. 2 lines 57-59 and 65-67: “ the stored value card is used till balance is zero and recipient being able to add value to the card via internet suggests the claimed steps of displaying, storing, and redisplaying the new face value, to apprise recipient of current value, after successive redemptions, and to enable adding more value”.

Applicant challenges to the Official Notices taken for claims 15-17 are still defective. The Applicant must rebut the Official Notice. This means that arguments must be presented as to why the Officially Noted Fact is not correct. Applicant did not do so. A mere request for documentation or statements that the claims are special are not rebuttals.

Thus “Applicant’s bald statements demanding support are not adequate and do not shift the burden to the examiner to provide evidence in support of Official Notice. Allowing such statement to challenge Official Notice would effectively destroy any incentive on the part of the examiner to use the process of establishing a rejection of notoriously well known facts.” *In re Boon*, 169 USPQ 231 (CCPA 1971). Since the challenge is defective, the Officially Noted Facts are taken as admitted. MPEP 2144.03.

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday, Wednesday, and Friday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

October 10, 2008

/Khanh H. Le/

Examiner, Art Unit 3688

/James W Myhre/

Supervisory Patent Examiner, Art Unit 3688